

1 Remarks

2 Amendments to the specification and claims

3 The specification, and claims 1, 3, 12, 18 and 20, have been amended as  
4 indicated above. The amendments to the specification and indicated claims have  
5 been presented in accordance with the proposed revisions to 37 C.F.R. 1.121 as set  
6 forth in 1267 OG 106 (25 February 2003).

7  
8 Objections to the specification

9 The specification has been amended as set forth above. Specifically: (1) in  
10 the paragraph at page 8, lines 3-13, at line 3 (in the original paragraph) a space has  
11 been inserted between "identifier" and "305; and (2) in the paragraph at page 9, lines  
12 17-25, at line 7 (in the original paragraph) "t" has been amended to be --to--.

13  
14 Objections to the claims

15 Claims 3, 12 and 20 were objected to since the term "BIT" is not defined in the  
16 claims. In response, claims 3, 12 and 20 have been amended to replace "BIT" with,  
17 --Broken Image Tracking ("BIT")--. Support for the amendment is found in the  
18 specification at page 4, lines 6-7.

19  
20 Rejection of claim 8 and 18 under 35 U.S.C. § 112

21 Claim 8 was rejected under 35 U.S.C. § 112 as being indefinite due to use of  
22 the term "substantially". The Applicants respectfully traverse. As set forth at MPEP  
23 § 2173.05(b)(D), the limitation of "substantially" can be definite, "because one of  
24 ordinary skill in the art would know what is meant by 'substantially equal'. (*Andrew  
25 Corp. v. Gabriel Electronics*, 847 F.2d 819, 6 USPQ2d 2010 (Fed Cir. 1988)." The  
Applicants contend that one of ordinary skill in the art of web page programming  
would understand that "inserting [a] command in [a] web page file so that it causes

1 substantially no error graphic to be displayed to the user” would understand what an  
2 acceptable error graphic display rate would be. The “error graphic” corresponds to a  
3 broken image (see page 7 lines 27-29). Broken images are a common occurrence in  
4 web page programs (see  
5 [http://math.dartmouth.edu/webwork\\_local/scans\\_for\\_broken\\_images/](http://math.dartmouth.edu/webwork_local/scans_for_broken_images/), which states,  
6 “Especially in large classes, one will often find broken gifs or pngs arising from a  
7 latex2html precreate run. Of course, it can happen any time latex2html is invoked.”  
8 (Emphasis added.)) Accordingly, “caus[ing] substantially no error graphic to be  
9 displayed” would mean at least that the error graphic is not displayed “often” (i.e., the  
10 error graphic is displayed less often than not). It is always the goal of web page  
11 programmers to achieve zero-error rates in graphic displays, but due to the constant  
12 introduction of new scripts and the like, this goal is elusive. Accordingly, some error  
13 rate is to be expected, and web page users accept this fact. For these reasons, the  
14 Applicants contend that claim 8 is definite, and respectfully request that the rejection  
15 of claim 8 as being indefinite now be removed.

16 Claim 18 was rejected under 35 U.S.C. § 112 as being indefinite for failing to  
17 provide an antecedent basis for, “the capacity”. In response, the expression, “the  
18 capacity” has been replaced with the expression, --a capacity--. The Applicants  
19 contend that this amendment renders claim 18 definite, and respectfully request that  
20 the rejection of claim 18 as being indefinite now be removed.

#### 21 22 Rejection of Claims under 35 U.S.C. § 102

23 Claims 1-5, 8-9, 12, 15-17 and 21 have been rejected under 35 U.S.C. § 102  
24 as being anticipated by U.S. Patent Application Publication No. 2002/0099812A1  
25 (“Davis”).

The Applicants respectfully disagree that claims 1-5, 8-9, 12, 15-17 and 21  
are anticipated by Davis.

1 As a starting point, the PTO and the Federal Circuit provide that §102  
2 anticipation requires each and every element of the claimed invention to be  
3 disclosed in a single prior art reference. (*In re Spada*, 911 F.2d 705, 15 USPQ2d  
4 1655 (Fed. Cir. 1990)). The corollary of this rule is that the absence from a cited  
5 §102 reference of any claimed element negates the anticipation. (*Kloster*  
6 *Speedsteel AB, et al v. Crucible, Inc., et al*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir.  
7 1986)). Furthermore, "[a]nticipation requires that all of the elements and limitations  
8 of the claims are found within a single prior art reference." (*Scripps Clinic and*  
9 *Research Found. v Genetech. Inc.*, 927 F.2d 1565, 1576, 18 U.S.P.Q.2d 1001, 1010  
10 (Fed. Cir. 1991 (emphasis added))). Moreover, the PTO and the Federal Circuit  
11 provide that §102 anticipation requires that there must be no difference between the  
12 claimed invention and the reference disclosure. (*Scripps Clinic and Research Found.*  
13 *v. Genetech, Inc.*, *id.* (emphasis added))). Accordingly, if the Applicants can  
14 demonstrate that any one element or limitation in claims 1-5, 8-9, 12, 15-17 and 21 is  
15 not disclosed by Davis, then the respective claim(s) must be allowed.

16 In the following arguments, the Applicants will focus in particular on  
17 independent claims 1, 9 and 21, as the Applicants believe those claims to be  
18 allowable (as either originally presented, or as amended above) over Davis. It is  
19 axiomatic that any dependent claim which depends from an allowable base claim is  
20 also allowable, and therefore the Applicants do not believe it is necessary to present  
21 arguments in favor of each and every dependent claim.

#### 22 23 Claim 1

24 The Applicants contend that claim 1, as amended (and claims 2-8 which  
25 depend therefrom) are not anticipated by Davis. With respect to independent claim  
1, that claim includes the following limitations:

1 A method for tracking the use of a web tool by a web user,  
2 comprising:

3 providing a web user through a web user computer access to a  
4 web tool;

5 transmitting to the web user computer one or more web page  
6 files in connection with the user accessing the web tool; and

7 inserting within at least one of the web page files, using the web  
8 tool, a command having embedded user information associated with  
9 the web user's use of the web tool,

10 the command causing the web user computer to transmit  
11 directly to a server, designated within the command, a request that  
12 includes the embedded user information, wherein the user  
13 information is stored in a database in response to the request being  
14 processed by the designated server.

15 (Emphasis added.)

16  
17 Support for the amendment to claim 1 is found in the specification at page 5  
18 lines 16-18, page 7 lines 6-8 and 19-20, and page 11 lines 6-8.

19 Davis does not provide for a "request" generated by a web tool server,  
20 wherein the request includes the embedded user information to be transmitted  
21 directly to a designated server, as is required by Applicants' claim 1. Rather, in  
22 Davis the "request" is a request for a designated server ("Server B" of Fig. 3 in  
23 Davis)) to provide a tracking program (see Davis ¶ 51, lines 5-8). The tracking  
24 program then accumulates user information and, after a designated period of time,  
25 transfers the user information to another server. (See Davis ¶ 51, lines 20-24.) The  
following table will help to distinguish the Applicants' invention over Davis.

1	<b>Applicants' claim 1</b>	<b>Davis</b>
2	User information is embedded into a web page by web tool.	User information is embedded into a web page by web tool.
3	The web tool inserts into the web page a command.	The web tool inserts into the web page a URL referencing a tracking program.
4	The command causes the web user computer to transmit (to a designated server) a request that includes the user information.	The web user computer uses the URL referenced by the web page to request a tracking program from Server B.
5	The <b>request</b> causes the designated server to directly store the user information in a database.	The web user computer acquires the tracking program.
6		The tracking program monitors the amount of time a web page is displayed.
7		The tracking program sends "amount of time a web page is displayed" info to a server (database), along with other client information.
8		
9		
10		
11		

12 As can be seen, a primary difference between the Applicants' invention (as  
13 set forth in Applicants' claim 1) and Davis is that Davis requires the additional steps  
14 of acquiring a tracking program, and then using the tracking program to monitor web  
15 page use, prior to sending any user information to the database. Applicants' claim 1,  
16 on the other hand, provides for the command in the web page to cause the user  
17 computer to transmit a request containing user information directly to a designated  
18 server, and for the designated server to then store the user information in a  
19 database.

20 For at least these reasons, the Applicants contend that claim 1 is not  
21 anticipated by Davis. Since claims 2-5 and 8 depend from claim 1 (either directly or  
22 indirectly), these claims include the limitations of claim 1. Accordingly, claims 2-8  
23 are also allowable over Davis. The Applicants therefore request that the rejection of  
24 claims 1-5 and 8 be removed and the claims allowed.

25 (Continued on next page.)

1 Claim 9

2 The Applicants contend that claim 9, and claims 10-18 which depend  
3 therefrom, are not anticipated by Davis. With respect to independent claim 9, that  
4 claim includes the following limitations:

5  
6 A system for tracking web users use of a web tool, comprising:  
7 a web tool server [] for providing to each web user computer  
8 one or more web page files [], the web tool server inserting within at  
9 least one of the web page files [] a **command** having embedded user  
10 information associated with a web user's use of the web tool; and  
11 a designated server [], wherein the **command** when executed  
12 by a web user computer causes the web user computer to transmit to  
13 the designated server a **request that includes the embedded user**  
14 **information**, wherein the user information is stored in a database in  
15 response to the request being processed by the designated server.  
16 (Emphasis added.)

17  
18 As can be seen, in Applicants' tracking system of claim 9 the "command"  
19 causes the user computer to transmit to the designated server a "request" that  
20 includes the embedded user information. That is, the user information is transmitted  
21 when the command is *executed* by the user computer. The designated server then  
22 stores the user information in the database. In Davis, by contrast, the "command"  
23 causes the user computer to send a request to the second server for a tracking  
24 program, and the user computer then uses the tracking program to track user  
25 information, and the tracking program then transmits the user information to the  
second server so that the information can be stored in a database. (See Davis at  
page 5 ¶ 51 lines 3-8 and 14-24.) That is, Davis does not provide for the "command"

1 to allow the user information to be sent directly to the second server when the  
2 command is executed, but instead requires the intervention of the tracking program.

3 For at least these reasons, the Applicants contend that claim 9 is not  
4 anticipated by Davis. Since claims 12 and 15-17 depend from claim 9 (either directly  
5 or indirectly), these claims include the limitations of claim 9. Accordingly, claims 12  
6 and 15-17 are also allowable over Davis. The Applicants therefore request that the  
7 rejection of claims 9, 12 and 15-17 as being anticipated by Davis be removed and  
8 the claims allowed.

9  
10 Claim 21

11 The Applicants contend that claim 21 is not anticipated by Davis. With respect  
12 to claim 21, that claim includes the following limitations:

13  
14 A computer program product for tracking the use of a web tool  
15 by a web user, the product having computer readable instructions  
16 thereon that when executed cause a computer to perform the following  
17 acts:

18 providing a web user through a web user computer access to a  
19 web tool;

20 transmitting to the web user computer one or more web page  
21 files in connection with the user accessing the web tool; and

22 inserting within at least one of the web page files a **command**  
23 having embedded user information associated with the web user's use  
24 of the web tool, the command causing the web user computer to  
25 transmit to a server, designated within the command, a request that  
includes the embedded user information, wherein the user

1 information is stored in a database in response to the request being  
2 processed by the designated server.  
3 (Emphasis added.)  
4

5 As can be seen, in the Applicants' computer program for tracking the use of a  
6 web tool of claim 21, the program causes a "command" to be inserted into a web  
7 page, and the "command" includes embedded user information. The "command"  
8 then causes the web user computer to transmit to a server a request that includes  
9 the embedded user information. In Davis, by contrast, the "command" causes the  
10 user computer to send a request to the second server for a tracking program, and  
11 the user computer then uses the tracking program to track user information, and the  
12 tracking program then transmits the user information to the second server so that the  
13 information can be stored in a database. (See Davis at page 5 ¶ 51 lines 3-8 and  
14 14-24.) That is, Davis does not provide for the "command" to allow the user  
15 information to be sent directly to the second server, but instead requires the  
16 intervention of the tracking program.

17 For at least these reasons, the Applicants contend that claim 21 is not  
18 anticipated by Davis. The Applicants therefore request that the rejection of claim 21  
19 as being anticipated by Davis be removed and the claim allowed.  
20

21 Rejection of Claims under 35 U.S.C. § 103(a)

22 Claims 6, 7, 10, 11, 13, 14 and 18-20 have been rejected under 35 U.S.C. §  
23 103 as being obvious over U.S. Patent Application Publication No. 2002/0099812A1  
24 ("Davis") in view of Morimoto et al (US 6,397,244) ("Morimoto").  
25



1 The Applicants respectfully disagree that claims 6, 7, 10, 11, 13, 14 and 18-20  
2 are obvious over Davis in view of Morimoto.

3 With respect to claims 6 and 7, those claims depend from claim 1. For the  
4 reasons stated above, the Applicants contend that claim 1 is allowable. It is  
5 axiomatic that any claim which depends from an allowable claim is also allowable.  
6 Accordingly, claims 6 and 7 are also allowable since they inherently include the  
7 limitations of claim 1. The Applicants therefore respectfully request that the rejection  
8 of claims 6 and 7 be removed and the claims allowed.

9 With respect to claims 10, 11, 13 and 14, those claims depend from claim 9.  
10 For the reasons stated above, the Applicants contend that claim 9 is allowable. It is  
11 axiomatic that any claim which depends from an allowable claim is also allowable.  
12 Accordingly, claims 10, 11, 13 and 14 are also allowable since they inherently  
13 include the limitations of claim 9. The Applicants therefore respectfully request that  
14 the rejection of claims 10, 11, 13 and 14 be removed and the claims allowed.

15 With respect to claims 18-20, as a starting point, MPEP 706.02(j) states:

16 "[t]o establish a *prima facie* case of obviousness, three basic  
17 criteria must be met. First, there must be some suggestion or  
18 motivation, either in the cited references themselves or in the  
19 knowledge generally available to one of ordinary skill in the art, to  
20 modify the reference or to combine the reference teachings.  
21 Second, there must be a reasonable expectation of success.  
22 Finally, **the prior art reference (or references when combined)**  
23 **must teach or suggest all the claim limitations.** The teaching  
24 or suggestion to make the claimed combination and the  
25 reasonable expectation of success must both be found in the prior  
art and not based on applicant's disclosure." (Emphasis added.)

1 Claim 18 includes the following limitations:

2  
3 A web tool system having a capability of tracking a user's use of  
4 a web tool, comprising:

5 a web tool server [] having a web tool program for generating  
6 and providing to the web user computer one or more web page files [];

7 a designated server []; and

8 a user information database server communicatively linked to  
9 the designated server, wherein the web tool program inserts into at  
10 least one of the one or more web tool pages for a web user session, a  
11 **command having embedded user information** associated with the  
12 web user's use of the web tool, the command causing the web user  
13 computer to transmit to the designated server a request that  
14 includes the embedded user information, wherein the designated  
15 server transfers the user information from the request to the user  
16 information database in response to processing the received request.

17 (Emphasis added.)

18  
19 As can be seen, in the web tool system of Applicants' claim 18, the  
20 command inserted by the web tool program into the web page not only  
21 includes the user information, but also causes the web user computer to  
22 transmit a request to the designated server that includes the user  
23 information. Neither Davis nor Morimoto show this limitation. As described  
24 above with respect to claims 9 and 21, Davis shows a command that includes  
25 user information and a "request", but the "request" of Davis is for a tracking  
program; no user information is sent to a designated server by the request, as  
is required by Applicants' claim 18. Further, Morimoto does not teach a web

1 tool server that inserts a command into a web page, wherein the command  
2 includes user information and a request that is sent to a designated server,  
3 and the request includes the user information, all as required by Applicants'  
4 claim 18

5 For at least these reasons, the Applicants contend that claim 18 is not  
6 obvious over Davis in view of Morimoto. Since claims 19 and 20 depend from  
7 claim 18 (either directly or indirectly), these claims include the limitations of  
8 claim 18. Accordingly, claims 12 and 15-17 are also allowable over Davis  
9 and Morimoto. The Applicants therefore request that the rejection of claims  
10 18-20 as being obvious over Davis in view of Morimoto be removed and the  
11 claims allowed.

12  
13 Summary

14 The Applicants believe that this response constitutes a full and complete  
15 response to the Office action, and therefore request timely allowance of claims 1  
16 through 21.

17 The Examiner is respectfully requested to contact the below-signed  
18 representative if the Examiner believes this will facilitate prosecution toward allowance of  
19 the claims.

20  
21 Respectfully submitted,

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23  
24 Date: May 5, 2003

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